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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/141,264	08/27/1998	TERRELL B. JONES	7099.0003	9665

826 7590 09/21/2004

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/21/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/141,264

Filing Date: August 27, 1998

Appellant(s): JONES ET AL.

Andrew T. Spence
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 July 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does contain a statement stating that there are no related appeals and/or interferences involving this application or its subject matter.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct. The appellant cancelled claim 59 in his amendment after Final, received on April 12, 2004, and the same was acknowledged and entered by the examiner in the Advisory action mailed on May 10, 2004. With the acceptance of cancellation of claim 59, rejected claims 1-58 will be considered for purposes of Appeal.

(4) Status of Amendments After Final

The amendment after final rejection filed on April 12, 2004 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct about prior art rejection. The brief does not include the issue of provisional double patenting rejection of claims 1-58 as presented in the Final office action, paper # 17. However, the same is acceptable in view of the appellant's statement in his amendment, paper # 16, received on August 26, 2003, that he would respond later such as by filing a Terminal Disclaimer.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-57 do stand or fall together and claim 58 stands or falls alone.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,948,040	DeLORME	9-1999
6,085,976	SEHR	7-2000
6,163,748	GUENTHER	12-2000

Press release, " ICL NETS CONTRACT FOR BIRMINGHAM TRANSIT INFO SYSTEM ", Intelligent Highway, v5, n2, pN/A, May 1, 1993, 1 page, word count 399, from Dialog database, Item 9 from file 16, document number

02834213, supplier number 43812678, extracted on Internet on 01/20/2003,
hereinafter, referred to as Press release

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The ground(s) for rejection are reproduced below and are provided here for the convenience of both the Appellant and the Board of Patent Appeals from:

- (i) Final Office Action, paper # 17, and
- (ii) Advisory action, paper # 21, mailed on May 10, 2004.

Final Office action, paper # 17:

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of co-pending Application No. 10/141,935. Although the conflicting claims are not identical, they are not patentably distinct from each other. The only difference in the claims 1-57 of both the applications is that claim limitations in the instant application include the phrase "that allows time for traveling between the intermediate point and the destination location". This property would be inherent in the existing claim of the co-pending application '935, while determining an arrival time and a secondary mode of transportation within a vicinity of the destination location using the located travel information to ensure arrival at the destination location by the appointment time.

The only difference between claim 58 of both the applications is that the co-pending application '935 does not include the phrase, "to ensure arrival at the destination location by the appointment time. However, this limitation would be obvious over the existing claim of the co-pending application '935 while recommending a plurality of travel options and recommending a plurality of secondary modes of transportation based on the travel goal to reach the destination location at an appointed time.

The only difference between claim 59 of both the applications is that the co-pending application '935 includes the phrase "select ground transportation" instead of "recommend one or more modes of ground transportation" as included in the instant application. However, the limitation of recommending one

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or more ground transportation would be obvious over the existing claim of the co-pending application '935 to enable the user to select one of the modes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-57 are rejected under 35 U.S.C. 103(a) as being obvious over DeLorme and in view of, Official Notice.

Regarding claim 1, DeLorme discloses a data processing system for processing travel requests using a travel database, comprising:

a memory including program instructions (column 14, lines 53-65); and a processor operating responsive to the program instructions to (column 14, lines 53-65); receive a travel goal specifying a destination location and an appointment time for arrival at the destination location (column 17, line 62-column 18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

access the travel database to locate travel information corresponding to the destination location (column 13, line 48-column 14, line 52); and

determine an arrival time at an intermediate point within a vicinity of the destination location using the located travel information to ensure arrival at the destination location by the appointment time (column 8, lines 33-39, column 34, line 57-column 35, line 8, column 40, line 57-column 41, line 5, column 51, lines 31-36 and column 19, lines 39-58).

DeLorme does not expressly disclose determining one mode of transportation between the intermediate point and the destination location based upon the travel goal. The examiner takes an Official Notice that determining manually one mode of transportation between the intermediate point and the destination location based upon the travel goal is old and well established in the field of traveling. For example, If a traveler who has to travel to Washington D.C. from New York, would inherently determine as which secondary mode of transport, such as taxi, private pick-up, metro, metro-bus, walking, rental-car, etc. would suit him based upon the cost and time available with him to reach his destination point in the city at the appointed time. A destination point could be an office for a meeting, a tourist spot, a residence, etc. depending upon his travel goal.

In view of Official Notice, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to a person having ordinary skill in the art to which the invention pertains that merely providing an automatic means to replace a manual activity, which accomplishes the same result is not sufficient to distinguish over the prior art. Factors and considerations dictated by law governing 35 U.S.C. 103 apply without modification to computer-related inventions. Moreover, merely using a computer to automate a known process does not by itself impart nonobviousness to the invention. See *Dann v. Johnston*, 425 U.S. 219, 227-30, 189 USPQ 257, 261 (1976); *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of determining one mode of transportation between the intermediate point and the destination location based upon the travel goal from a customer gives you just what you would expect from the manual step as shown in Official Notice above. In other words, there is no

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enhancement found in the claimed step. Automation can simply determine it faster but the result is the same. Therefore, it would be obvious at the time of the applicant's invention to incorporate the old and well-known step, with automation, to determine a secondary mode of transport, such as taxi, private pick-up, metro, metro-bus, walking, rental-car, etc. to reach his destination point. Doing so would enable the traveler to select a mode of transport that would suit him best based upon the cost and time available to him to reach his destination point in the city at the appointed time.

Regarding claim 2, DeLorme further discloses a plurality of travel stations are within the vicinity of the destination location, and wherein the processor further operates responsive to the program instructions to:

select one of the plurality of travel stations (column 18, line 58-column 19, line 8); and determine available modes of transportation between the selected travel station and the destination location (column 8, lines 33-58).

Regarding claim 3, DeLorme further discloses the processor further operates responsive to the program instructions to:

display the available modes of transportation (column 23, lines 45-63); and receive a selection of one of the available modes of transportation (column 18, line 58-column 19, line 8).

Regarding claim 4, DeLorme further discloses the travel information includes a plurality of travel options available at the travel station, and wherein the processor further operates responsive to the program instructions to:

select one of the plurality of travel options that arrives at the travel station at the time of arrival sufficient to ensure arrival at the destination location by the appointment time (column 17, lines 44-60).

Regarding claim 5, DeLorme further discloses the processor further operates responsive to the program instructions to display data listing the plurality of travel options (column 25, lines 35-65); and receives an indication of a selected travel conveyance (column 40, lines 38-56).

Regarding claim 6, DeLorme further discloses the processor further operates responsive to the program instructions to:

display data listing the plurality of travel options (column 25, lines 35-65); and receive an indication of a selected travel flight (column 40, lines 48-50).

Regarding claim 7, DeLorme further discloses the instructions to maintain a profile of travel preferences, wherein the travel option section is based on the travel preferences (column 61, lines 10-26).

Regarding claim 8, DeLorme further discloses the processor further operates responsive to the program instructions to:

receive a travel return date (column 51, line 23-column 52, line 23); and display a list of return travel options from the travel station on the travel return date (column 51, line 23-column 52, line 23).

Regarding claim 9, DeLorme further discloses the processor further operates responsive to the program instructions to:

determine whether an overnight stay is required (column 17, lines 55-58 and column 18, lines 48-51); and display a list of hotels for selection (column 22, lines 43-51).

Regarding claim 10, DeLorme further discloses the processor further operates responsive to the program instructions to:

receive a selection of one of the hotels (column 74, lines 20-25); and reserve a room at the selected hotel (column 74, lines 20-25).

Regarding claim 11, DeLorme further discloses the processor further operates responsive to the program instructions to locate restaurants in a vicinity of the destination site (column 49, line 60-column 50, line 26).

Regarding claim 12, DeLorme further discloses the processor further operates responsive to the program instructions to search a restaurant database for restaurants in the vicinity of the destination location (column 48, lines 47-67).

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Regarding claim 13, DeLorme further discloses the processor further operates responsive to the program instructions to locate restaurants includes an instruction to display the determined restaurants (column 50, lines 27-67).

Regarding claim 14, DeLorme further discloses the processor further operates responsive to the program instructions to locate activities in a vicinity of the destination location (see figures 7A and 7B).

Regarding claim 15, DeLorme further discloses the processor further operates responsive to the program instructions to: search an activities database for the activities in the vicinity of the destination location (column 30, lines 1-17).

Regarding claim 16, DeLorme further discloses the processor further operates responsive to the program instructions to: locate activities includes an instruction to display a list of the determined activities (figures 7A and 7B).

Regarding claim 17, DeLorme further discloses the processor further operates responsive to the program instructions to provide travel information in accordance with the determined arrival time (column 17, lines 14-43).

Regarding claim 18, DeLorme further discloses the travel information includes geographic data for travel between the travel station and the destination (figures 1B-1C).

Regarding claim 19, DeLorme further discloses the travel goal may include a plurality of legs of travel each leg of travel including a different destination location and appointment time for arrival at the destination location (column 44, lines 43-61).

Claims 20-38 are written in computer software with parallel limitations found in claims 1-19, therefore are rejected as obvious over DeLorme in view of the Official Notice by the same rationale.

Claims 39-57 are written in function method with parallel limitations found in claims 1-19, therefore are rejected as obvious over DeLorme in view of the Official Notice by the same rationale.

7. Claims 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme and further in view of, Press release.

Regarding claim 58, DeLorme discloses a method for processing travel requests including the steps of:

receiving a travel goal including a destination location and an appointment time (column 17, line 62-column 18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

recommending a plurality of travel options and recommending a secondary mode of transportation based on the travel goal to ensure arrival at the destination location by the appointment time (column 17, lines 44-60; column 40, lines 38-56 and figures 7A-7B, column 8, lines 33-39, column 34, line 57-column 35, line 8, column 40, line 57-column 41, line 5, column 51, lines 31-36 and column 19, lines 39-58. Note: car rentals correspond to the secondary mode of transportation).

invoking a transportation decision system to select one of the plurality of travel options and a secondary mode of ground transportation based on the recommended travel options and the recommended secondary ground transportation (column 14, lines 19-43, col.21, lines 63-66, col.23, lines 56-63);

determining whether an overnight stay is required (column 17, lines 55-58 and column 18, lines 48-51);

invoking a hotel decision support system to select a hotel when it is determined that an overnight stay is required (figures 7A-7B); and

invoking an activity and restaurant decision support system to select activities and restaurants in a vicinity of the destination location (figures 7A-7B).

DeLorme further teaches selection of a plurality of secondary modes of transportation, see col.21, lines 63-66, col.23, lines 56-63. TRIPS discloses other modes of transportation like, walking, subway, biking, plane, car, public transport which can be made available to the user to select.

DeLorme does not disclose recommending a plurality of second modes of transportation to ensure arrival at the destination location by the appointment time.

However, Press release, teaches recommending alternative transportation modes to passengers on interactive terminals (see the entire article, "....The system will also recommend alternative transportation modes and routes to passengers"). By recommending alternative plurality of transportation modes like

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buses and trains the system will be able to provide the best information on expected delays, arrival times of the busses and enabling the passengers to calculate transit routes both by bus and train to their selected destinations. In view of the Press release, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to have modified DeLorme to include recommending alternative ground transportation modes to the user to enable him calculate the transit route and select the one as per his preference , his budget and the time available to reach his destination.

Regarding claim 59, DeLorme discloses a memory for access by a computer including:
a travel goal subsystem for receiving a travel goal including a destination location and an appointment time (column,17, line 62-column,18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

a transportation subsystem having instructions to select modes and times of transportation based on the travel goal (figures 2, items 221 and 223);

a hotel subsystem having instructions to select hotel in a vicinity of a destination site (figure 2, item 213);

activity and restaurant subsystem having instructions to select activities or restaurants near a destination site (figure 2, item 213);

DeLorme further teaches a subsystem for selection of a plurality of secondary modes of transportation, see col.21, lines 63-66, col.23, lines 56-63. TRIPS discloses other modes of transportation like, walking, subway, biking, plane, car, public transport which can be made available to the user to select. DeLorme does not disclose a ground transportation subsystem having instructions to recommend one or more modes of ground transportation to a destination site. However, Press release, teaches ground transportation subsystem having instructions to recommend one or more modes of ground transportation to a destination site to passengers on interactive terminals (see the entire article, ".....*The system will also recommend alternative transportation modes and routes to passengers*""). By recommending one or more modes of ground transportation like buses and trains, the system will be able to provide the best information on expected delays, arrival times of the busses and enabling the passengers to calculate transit routes by both bus and train to their selected destinations. In view of the Press release, it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify DeLorme to include recommending one or more modes of transportation to the user to enable him calculate the transit route and select the one as per his preference, his budget and time available to reach his destination point.

Advisory action, paper # 21, mailed on May 10, 2004:

Continuation of 5. does NOT place the application in condition for allowance because:

In order to satisfy the applicant's challenge to the Official Notice taken by the examiner in the Final Office action, two references (US Patent 6,163,748 to Guenther and US Patent 6,085,976 to Sehr) are enclosed as evidence and to substantiate the Official Notice taken by the examiner. See Guenther, at least Col.1, lines 21-66, " The invention relates to a method and apparatus for controlling transport and travel operations, in which the route between the starting point and the destination point, which is optimized under preselectable aspects, is determined and made available by means of a computer on the basis of stored general information, by way of the junction points of a traffic network. Various methods of this type are known. They are essentially based on data collections (as a rule, on CD-ROM), which contain the data of a traffic network, such as a road, railroad or flight network, and use a computer which determines the most favorable route between two or optionally several points of the respective network. In this case, parameters, such as price, speed, route distance or the like, are taken into account. The user enters the starting point (locality, street) and the destination, and receives a corresponding route plan.....be taken into account in order to generate an optimal route suggestion. Thus, it is of interest, for example, whether or not the traveler has luggage to be transported. In addition, the junction points of normal traffic networks are relatively loosely distributed so that, although the smallest element that can be used within a city may be a street, for example; within a country, the smallest element that can be used may only be a "city district" or the like.It is an object of the invention to provide a method which permits the use of all relevant information for the connection possibilities between an exact starting point and an exact destination point to establish an optimal route plan. In addition to the automobile, this includes all rail-bound short-distance and long-distance means of transport and air traffic. Part of the new approach is a communication concept which is to be utilized intuitively and which ensures an easy access to the system by the users. ". See also Sehr at least col.7, lines 25-47, " FIG. 2 illustrates the Travel Center (2) that provides the

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computerized means Such a center can be, for example, a provider of virtual services that are delivered via remote ticket offices, electronic shopping malls, or on-line travel support functions. Also shown is a Passenger Station (31) that controls access to the transportation carriers, as well as monitors possible connections relating to a particular travel itinerary including alternative transportation means. Means for transportation may include airplanes, railroads, ships, automobiles, subways, buses, or rental cars. " , and col.9, lines 20-31, " ... The travel map (22) lets the user explore various travel itineraries, while automatically providing alternative routes and related recommendations. For example, the passenger inputs into, or points and clicks on, the map the departure and destination locations, including the date of travel and number of tickets requested. In response thereto, the map compiles and provides a set of possible itineraries, including the ticket price and the departure and arrival times associated with the recommended alternatives. Should the trip require any connections, the map will also provide the necessary information, including the type of carriers and time/location of transfer. " .

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

From these references, the Official Notice taken by the examiner in the previous Final Office action, page 7, to show, that determining one mode of transportation between the intermediate point and the destination location based upon the travel goal is old and well established in the field of traveling is evident and justified. In view of this, the rejection of claims 1-57 stands good as submitted in the previous Final Office action and, therefore, the application cannot be placed in condition for allowance. As regards claim 58, the examiner has considered the applicants' arguments but not found persuasive.

(11) Response to Argument

A. Whether Claims 1-57 are properly rejected under 35 U.S.C. 103

(a) based on DeLorme and Official Notice:

11.1. The appellant argues with regards to independent claims 1, 20 and 39 that the Official Notice of facts taken by the examiner is not capable of instant and unquestionable demonstration as being well known so as to defy dispute by explaining that a traveler who has never visited the intermediate and/or destination location or is having no prior knowledge of the intermediate and/or destination location will be incapable of determining a mode of transportation between intermediate location based upon a travel goal , as recited by the

claimed invention (see Brief, page 3, line 6-page 4, line 26). The examiner respectfully disagrees for the following reasons:

(i) In response to applicant's argument that the Official Notice taken by the examiner fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a traveler who has never visited the intermediate and/or destination location or is having no prior knowledge of the intermediate and/or destination location will be incapable of determining a mode of transportation between intermediate location based upon a travel goal , as recited by the claimed invention) are not recited in the rejected claim(s) 1, 20 and 39. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(ii) The examiner analyzed and acknowledged that the reference Delorme disclosed all the limitations of the independent claims 1, 20, and 39 except for the limitation, "determine at least one mode of transportation between the intermediate point and the destination location based upon the travel goal" (see Final Office action, pages 6-7). The examiner took Official Notice of the notoriously well-known fact of determining at least one mode of transportation between the intermediate point and the destination location based upon the travel goal, as analyzed in the Final office action, pages 7-8. The recited limitation, "determine at least one mode of transportation between the intermediate point and the destination location based upon the travel goal" does not specify that the determining function is **limited only to** a traveler who has never visited the intermediate and/or destination location or is having no prior knowledge of the intermediate and/or destination location. Instead, the recited

limitation, "determine at least one mode of transportation between the intermediate point and the destination location based upon the travel goal", covers all travelers irrespective of the fact if they have or have not prior knowledge of the intermediate and destination stations. Therefore, at least for those travelers who have prior knowledge of the intermediate and destination locations and the available transportation modes between the intermediate and destination location, it will be obvious for them to determine at least one mode of transportation between the intermediate point and the destination location based upon the travel goal, as explained in the Final office action (see pages 7-8). Therefore, it is evident that the applicant has neither traversed the facts and benefits of the Official Notice, taken by the examiner, specifically applicable for those travelers who have prior knowledge of the intermediate and destination locations and the available transportation modes between the intermediate and destination location.

(iii)The examiner further analyzed (see Final Office action, page 8) that It was also known at the time of the applicant's invention that merely providing an automatic means to replace a manual activity, which accomplishes the same result is not sufficient to distinguish over the prior art. Factors and considerations dictated by law governing 35 U.S.C. 103 apply without modification to computer-related inventions. Moreover, merely using a computer to automate a known process does not by itself impart nonobviousness to the invention. See *Dann v. Johnston*, 425 U.S. 219, 227-30, 189 USPQ 257, 261 (1976); *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of determining one mode of transportation

between the intermediate point and the destination location based upon the travel goal from a customer gives you just what you would expect from the manual step as shown in Official Notice above. In other words, there is no enhancement found in the claimed step. Automation can simply determine it faster but the result is the same.

In view of the foregoing, the applicant's traverse of the examiner's assertion of the Official Notice is not adequate and as per *MPEP-2144.03 [R-1] C Reliance on Common Knowledge in the Art or "Well Known" Prior Art* -, the common knowledge or well-known fact considered as Official Notice in the art statement is taken to be admitted prior art and the rejection of independent claims 1, 20 and 39 and their dependencies 2-19, 21-38 and 40-57 is to be maintained.

11.2. The applicant further argues that the references Guenther and Sehr, submitted in the Advisory action, paper # 21 on May 10, 2004 as evidences do not substantiate the Official Notice taken of the well-known fact to determine at least one mode of transportation between the intermediate point and the destination location based upon the travel goal (see Brief, page 4, line 27-page 6, line 5). The examiner disagrees for the following reasons:

(i) In response to applicant's argument that the references Guenther and Sehr fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *including an appointment time for arrival at the destination location*, see Brief, page 5, lines 4-7 or determining a secondary mode of

transportation from an intermediate point to a destination location, much less *based upon the time available to the traveler to reach the destination location by an appointment time*, see Brief, page 6, lines 2-5) are not the limitations for which the examiner took Official Notice. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As already analyzed above, the examiner took Official Notice for the limitation, "determining at least one mode of transportation between the intermediate point and the destination location based upon the travel goal ". This recited limitation does not include limitations such as, " *including an appointment time for arrival at the destination location* " and " *based upon the time available to the traveler to reach the destination location by an appointment time*", as claimed by the applicant in his arguments.

(ii) It is to be noted that the examiner analyzed in the Final Office action, see pages 6-7, that Delorme discloses the following recited limitations of each of the independent claims 1, 20 and 39,:

" a memory including program instructions; and a processor operating responsive to the program instructions to: receive a travel goal specifying a destination location and an appointment time for arrival at the destination location; access the travel database to locate travel information corresponding to the destination location; and determine an arrival time at an intermediate point within a vicinity of the destination location using the located travel information to ensure arrival at the destination location by the appointment time. "

The examiner's Official Notice was directed to the limitation "determining at least one mode of transportation between an intermediate point and a destination location, based upon a travel goal", only. In his arguments to prove that the references Guenther and Sehr do not substantiate the Official Notice taken of the fact of "determining at least one mode

of transportation between an intermediate point and a destination location, based upon a travel goal " , the appellant has combined the limitations " *including an appointment time for arrival at the destination location* " and " *based upon the time available to the traveler to reach the destination location by an appointment time*" , which are already analyzed by the examiner as disclosed by DeLorme. Therefore, the above cited arguments of the appellant are attacking the references individually rather than the combined reference of DeLorme in view of Official Notice. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(iii) It was analyzed in the Advisory action, paper number 21 mailed on May 10, 2004 that the reference Guenther suggests "determining at least one mode of transportation between an intermediate point and a destination location, based upon a travel goal" , see at least col.1, lines 21-67, "...*It is an object of the invention to provide a method which permits the use of all relevant information for the connection possibilities between an exact starting point and an exact destination point to establish an optimal route plan. It is another object of the invention to carry out a proportion of the overall mobility which is as large as possible in an efficient and environmentally compatible manner such that all available public and private traffic means and systems are optimally utilized and used according to their strengths. In addition to the automobile, this includes all rail-bound short-distance and long-distance means of transport and air traffic. Part of the new approach is a communication concept which is to be utilized intuitively and which ensures an easy access to the system by the users.*". Note: Guenther is very explicit in suggesting to consider all possible transport modes between a

starting point [corresponds to an intermediate location in the applicant's claimed limitation] and a destination point and then utilize the best transport mode depending upon such strengths as overall mobility, availability and efficiency. See col.2, lines 15-40, which shows selecting a best possible transportation mode to travel between two points [one could be termed as an intermediate and the other as destination] such as, a short walk, or access by car. See also col.4, lines 8-65, and col.5, lines 7-25 and 38-43).

(iv) It was analyzed in the Advisory action, paper number 21 mailed on May 10, 2004 that the reference Sehr suggests "determining at least one mode of transportation between an intermediate point and a destination location, based upon a travel goal" , see at least col.9, lines 20-31, "*The travel map (22) lets the user explore various travel itineraries, while automatically providing alternative routes and related recommendations.* For example, the passenger inputs into, or points and clicks on, the map the departure and destination locations, including the date of travel and number of tickets requested. In response thereto, the map compiles and provides a set of possible itineraries, including the ticket price and the departure and arrival times associated with the recommended alternatives. Should the trip require any connections, the map will also provide the necessary information, including the type of carriers and time/location of transfer. ". Note: Here, Sehr explicitly shows that the travel map (22) recommends alternative solutions related to carriers , that is transportation modes to travel between two points [one point corresponds to an intermediate point and the other to destination location] , and these transportation means could be chosen from air-travel, train, car, subways, etc. (see col.7, lines 45-57).

B Whether Claim 58 is properly rejected under 35 U.S.C. 103 (a) based on DeLorme and Press Release:

11.3. The appellant argues that the reference Press release does not teach or suggest recommending a plurality of secondary modes of transportation based on the travel goal to ensure arrival at the destination location by the appointment time and that does not provide the basis of its recommendations (see Brief, page 7, lines 10-12 and lines 21-23). The examiner respectfully disagrees. Press release does show a plurality of secondary modes of transportation based on the travel goal to ensure arrival at the destination location by the appointment time and also the basis of recommendation for the same (.. “*The system will also recommend alternative transportation modes and routes to passengers through specially designed interactive terminals*”, with “*expected arrival times*”, in view of “*expected delays, special events and fares*”. The basis of such recommendation is expected delays, special events which could affect the arrival time of the transportation carriers to various destination locations , which obviously is the travel goal of the passengers to reach in time at their offices or homes).

11.4. The appellant further argues that, “ the Press release does not recommend secondary modes of transportation based on the travel goal since it’s the user, and not the system, that determines the secondary mode of transportation based on a travel goal “ (see Brief page 8, lines 1-3). The examiner respectfully disagrees. In response to applicant's argument that the reference Press release fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., determining the secondary mode of transportation based on a travel goal) are not

recited in claim 58. The claim recites the limitation specifying recommending secondary modes of transportation and the same is suggested by Press release, as analyzed above. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the above reasons, it is believed that the rejections of claims 1-58 should be sustained.


Respectfully submitted,
Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 15, 2004

Conferees


Mr. John Weiss
SPE Art Unit 3629


Mr. Jeffrey A. Smith
Acting SPE Art Unit 3625

FINNEGAN HENDERSON FARABOW GARRETT &
DUNNER
1300 I STREET NW
WASHINGTON, DC 20005